

(Practitioner's Docket No. PAT00383/BC1-0033)

REMARKS

Upon entry of the present amendment claims 1-10 and 13-17 are pending in the application. Claim 1 has been amended. Amended claim 1 adds no new matter, as support for this claim can be found in original claims 1 and 12.

1. Rejection of claims 1-15 under 35 U.S.C. §102(b) as being anticipated by European Patent No. 1 092 758, hereafter "EP '758".

With respect to claims 1, 2 and 6-8, the PTO states:

"The European Patent teaches a curable composition comprising a hydrophobic silica and a hydrophilic silica, wherein the hydrophilic silica exhibits a primary particle diameter of 10 to 30 m μ (millimicrons, also known as nanometers), and a specific surface area preferably ranging from about 50 to 800 m²/g. See paragraphs [0015] and [0074] of the European Patent."

(Office Action of 3/21/2006, pages 2-3)

Applicants greatly appreciate the detailed basis of rejection, however in view of the new amendment to claim 1, Applicants respectfully request reconsideration.

To anticipate a claim, a single source must contain all of the elements of the claim. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986).

EP '758 does not meet this standard. In particular, EP '758 does not teach or suggest a "coating material [that] comprises the nanoparticles (A) and (B) in an amount of from 0.8 to 3% by weight, based on the total weight of the coating material" as required by amended independent claim 1.

As to original claim 12, whose limitations have been incorporated into amended claim 1, the PTO has stated:

The silicas [of EP '758] are present in the curable composition in amounts ranging from 1 to 100 parts by weight (pbw), based on an organopolysiloxane component. See paragraph [0078] of the European Patent. While this disclosure makes reference to either silica, the reference discloses a composition containing both silicas (paragraph [0015], as discussed above); from those teachings one

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skilled in the art would deduce that a composition containing both a hydrophobic silica and a hydrophilic silica would do so in at the very least, equal amounts (i.e., 50 pbw of each silica).

This disclosure is considered read upon claims 11-13.

(Office Action of 3/21/2006, pages 3-4)

Applicants respectfully submit that this disclosure does not read upon amended independent claim 1.

EP '758 discloses a range of parts by weight silica per 100 parts by weight of an organopolysiloxane component. (EP '758 paragraph 78) These ranges are very broad and do not teach a coating composition comprising a narrow range of silica concentrations as is required in Applicants' amended claim 1. Further, as taught by the EP '758 application, the coatings comprise various other material besides the silica, and the organopolysiloxane component such as silicone oils and organosilanes or a partial hydrolyzate thereof, along with "antifouling agents, plasticizers, inorganic dehydrating agents (stabilizers), metal salts of carboxylic acids, antisagging/antisetting agents (thixotropic agents), pigment, other coating form components, other fillers, fire retardants, thixotropic agent, heat conduction improvers, solvents, mildewproofing agents, germicides, flattening agents, perfumes, and the like." (EP '758, paragraph 108.)

Thus, the very broad range of parts by weight silica per 100 parts by weight of the organopolysiloxane component disclosed in EP '758 does not teach a specific concentration of silica in the overall composition. In particular, EP '758's very broad range of parts by weight silica per does not give any indication as to the amounts of silica component in the overall composition. Therefore, EP '758 does not teach a composition which includes the two types of nanoparticles in "a coating material [that] comprises the nanoparticles (A) and (B) in an amount of from 0.8 to 3% by weight, based on the total weight of the coating material" as required by independent claim 1.

Further, the example compositions of the EP '758 reference have much higher concentration levels of silica than the concentration level required by Applicants' amended claim 1.

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For example, in the EP '758 reference, Example Compositions 1, 2, 3, and 4 have 13.3 weight % silica, 12.6 weight % silica, 12.6 weight % silica, and 13.3 weight % silica, respectively. Further, in the EP '758 reference, Examples Compositions 6, 7, 8, and 9 have 10.3 weight % silica, 8.1 weight % silica, 13.2 weight % silica, and 6.8 weight % silica, respectively. Therefore, EP '758 only teaches compositions having silica concentrations that are much higher than those required by Applicants' amended claim 1. Thus, EP '758 does not teach or suggest a compound having "nanoparticles (A) and (B) in an amount of from 0.8 to 3% by weight, based on the total weight of the coating material" as required by Applicants' amended independent claim 1.

Therefore, the EP '758 reference does not teach the particular composition claimed by the Applicants' that provides the advantages described in Applicants' Specification. As described in Applicants' Specification, Applicants' invention provides a novel coating material "which no longer has the disadvantages of the prior art, which can be produced simply and very reproducibly, and which provides coatings, especially clearcoats, which are scratch-resistant, clear, transparent, highly glossy, and brilliant, and which have very good evenness and very good smoothness. (See Applicants' Specification paragraph 8).

Further, Applicants' claimed composition of amended claim 1 comprises relatively low amounts of silica (amounts from 0.8 to 3% by weight) as compared with the relatively high amounts of silica (amounts 6.8% by weight and greater) taught by the EP '758 reference. Therefore, Applicants' composition of amended claim 1 will not have the costs associated with the high concentrations of silica nanoparticles required by EP '758.

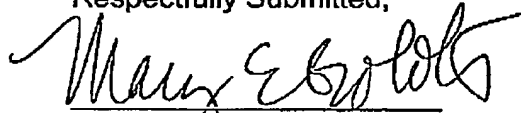
Therefore, reconsideration and removal of the anticipation rejection of claims 1-10 and 13-17 is respectfully requested in view of the foregoing amendments and remarks.

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CONCLUSION

Applicant(s) respectfully submit that the Application and pending claims are patentable in view of the foregoing amendments and/or remarks. A Notice of Allowance is respectfully requested. As always, the Examiner is encouraged to contact the Undersigned by telephone if direct conversation would be helpful.

Respectfully Submitted,



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